

## **REMARKS**

Claims 1-3 and 7 are pending in this application. By this Amendment, claims 1-3 have been amended and claim 7 has been added. It is respectfully submitted that no new matter has been added.

### **I. CLAIM OBJECTIONS**

The informalities of claims 1 and 2, as noted by the examiner, have been corrected.

### **II. 35 USC § 112 CLAIM REJECTIONS**

Claims 1-3 are rejected under 35 U.S.C. §112, second paragraph, as having several instances of limitations with insufficient antecedent basis. Accordingly, each of claims 1-3 have been amended to correct any limitations having insufficient antecedent basis. Removal of this rejection is respectfully requested.

### **III. 35 USC § 102 CLAIM REJECTIONS**

Claims 1 and 2 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,703,783 to Allen et al. (the '783 patent). This rejection is respectfully traversed.

Claims 1 and 2 both positively recite limitations directed to an inserting apparatus. As defined by its specification, inserting apparatus is defined as a device consisting of numerous components each cooperating with each other to assemble mailpieces in high-volume quantities. That is, in addition to addressing a mailpiece, they actually generate the mailpiece. See page, 7, paragraph 28 to page 9, paragraph 35 of the specification of the instant application.

In regards to the '783 patent, the examiner asserts that the labeler 112 of the '783 patent anticipates the recited "inserting apparatus." Applicants respectfully disagree as they submit the labeler of the '783 patent is nothing more than that. That is, a device that generates labels to be affixed to a mailpiece. It has nothing to do with the generation of

mailpieces. Clearly it does not perform any folding, inserting, sealing, . . etc, a typical inserting apparatus would do.

For at least this reason, it is respectfully submitted that removal of this 35 USC § 102 rejection is warranted.

#### **IV. 35 USC § 103 CLAIM REJECTIONS**

Claims 1 and 2 stand rejected under 35 U.S.C § 103 as being obvious over U.S. Patent No. 4,632,252 to Haruki et al. (the '252 patent) in view of U.S. Patent No. 6,119,051 to Anderson, Jr. et al. (the '051 patent).

Both claims 1 and 2 have been amended to be respectively directed to a system and method for detecting "return-to-sender" mailpieces and then providing updated addressing information for each "return-to-sender" mailpieces. This updated information is stored in a "return mail workstation database." This information can then be shared with the electronic files of an inserting apparatus.

Since neither the '252 patent or the '051 patent contain teachings regarding the detecting of, and subsequent processing of, "return-to-sender" mailpieces, they nether alone, or in combination with one, render obvious the recited invention of claims 1 and 2. Accordingly, it is respectfully submitted that independent claims 1 and 2, along with depending claim 3, patentably distinguishes from both the '252 and '051 patents, and thus, removal of this rejection is requested.

#### **V. NEWLY ADDED CLAIM**

Newly added claim 7 consists of the recitations of original claims 2 and 3. As indicated by the examiner during a telephone conversation on March 10, 2004, original claim 3 would be allowable so long as the 35 USC § 112 claim rejections applied to it, and its intervening claim (e.g., claim 2), were overcome. Since, as indicated above, the outstanding 35 USC § 112 rejection has been overcome, newly added claim 7 is now in condition for allowance.

V. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that pending claims 1-3 and 7 are now in a condition for allowance and favorable action thereon is requested. If the Examiner should have any questions, he is kindly urged to contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Capelli', written over a horizontal line.

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